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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/302,552	04/30/1999	STEPHEN SAVITZKY	15358-46	7040

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 10/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

3

**Office Action Summary**

Application No.

09/302,552

Applicant(s)

SAVITZKY ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communications: amendment B file 07/16/2003 to the original application filed 04/30/1999.
2. Claims 1-12 are currently pending in this application. Claims 1 and 9 have been amended by Applicant. Claims 1 and 9 are independent claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Wang et al.** (U.S. 5,237,679 – filed 05/1990) in view of **Schmid et al.** (U.S. 5,569,164 – filed 10/1996) and further in view of **Khan et al.** (U.S. 6,401,206 – filed 03/1998).

**As to independent claim 1**, Wang teaches in an electronic document handling system, a method of associating documents (it is now possible to electronically group multiple documents together in a manner which is analogous with paper office techniques; col.1, line 55 – col.2, line 12), comprising the steps of:

- generating a staple data object, for representing an association of selected pages and selected documents (a temporary stapler document relationship may be created by stapling a first document to a second document; col.2, lines 35-56);

- generating an electronic cover sheet for the staple data object (a temporary electronically designated folder; Abstract /associated pages of a single document can be visually identified and electronically “stapled” or assembled together with appropriate software ...a cover page which contains both machine and human-readable information col.1, line 45 – col.2, line 44).

- accepting from a user a list of at least one page of at least one electronic document (document relation object 48 is utilized to describe the logical relationships between the present document and other documents; col.4, lines 52-68);

- accepting a staple instruction from a user (*document is stapled to another document; col.4, lines 52-68*).

- securing the staple data object in response to receipt of the staple instruction (*document model object 40 may contain locking information; col.4, lines 21-44*), thereby indicating the existence of the association of selected pages and selected documents together at one time (*if the present document ... object 48; col.4, lines 52-68 & determination of whether or not a relationship exists between the document; col.5, lines 44-51*).

However, Wang does not explicitly teach “referencing each page or each electronic document in the list as an item of the staple data object.”

Schmid suggests referencing each page or each electronic document in the list as an item of the stack object (*associated pages of a single document can be visually identified and electronically "stapled" or assembled together; col.1, lines 40-50*).

It would have been obvious to a person of ordinary skill in the art of the time of the invention was made to combine the teachings of Schmid with Wang because it would have provided the capability for organizing groups of documents when performing electronic stapling.

The combination of Wang and Schmid does teach "securing the staple data object in response to receipt the staple instruction, thereby indicating the existence of the association of selected pages and selected documents together at one time", but is silent on the use of cryptography.

Khan teaches cryptographically securing the staple data object in response to receipt of the staple instruction (the concatenation is then presented to the conventional cryptographic; col.11, lines 23-34).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Khan's teaching in the system of Wang as modified by Schmid because it would have provided the enhanced capability for establishing the integrity of document, and ensuring non-repudiation of origin to the extent that it was signed by the user's private key.

**As to dependent claim 2**, Wang teaches accepting a manually input list (col.4, lines 52-68).

**As to dependent claim 3**, Wang teaches accepting a computer-generated list (col.4, lines 52-68).

**As to dependent claim 4**, Wang teaches presenting a user with an online form as an aid to selecting pages or documents for association as a stack (col.5, lines 9-51).

**As to dependent claim 5**, Wang teaches a step of prompting for the staple instruction by presenting the user with a stapler icon which, when selected, represents the staple instruction (col.4, lines 52-68).

**As to dependent claim 6**, Wang teaches a step of copying the selected pages and selected documents in a stack to static storage (col.5, lines 9-34).

**As to dependent claim 7**, Wang teaches a step of copying the selected pages and selected documents in a stack to a local storage device local to the electronic document handling system (col.5, lines 9-34).

**As to dependent claim 8**, Wang teaches (col. 6, lines 12-58) displaying a first list of documents, wherein the first list of documents lists the documents that are selected for inclusion in an open stack; displaying a second list of document, wherein the second list of documents list documents that have not been selected for inclusion in an open stack; and displaying a user interface control operative to obtain selections from a user of documents from the second list for inclusion in an open stack.

**As to dependent claim 10**, Khan discloses using a stack signature to secure the stack object, wherein the stack signature is a checksum of the contents of all the selected pages and selected documents in the stack, signed by the digital signature of a user or the digital signature

Art Unit: 2176

or private key of a system (the checksum is digitally signed using cryptography; col.2, lines 1-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Khan's teaching in the system of Wang as modified by Schmid because it would have provided the enhanced capability for establishing the integrity of document, and ensuring non-repudiation of origin to the extent that it was signed by the user's private key.

**As to dependent claim 11**, Wang discloses storing the electronic cover sheet in a stack database, where it can be referenced (col.4, lines 1-6).

**As to dependent claim 12**, Wang discloses generating controls for adding and deleting selected pages and selected documents from the stack (Version control object; col.5, lines 1-43).

**As to independent claim 9**, the rejection of independent claim 1 above is incorporated herein in full. However, claim 9 further recites:

- opening a secured stack upon receipt of a stack open instruction;
  - presenting the contents of the secured stack for perusal by the user;
  - accepting additions and deletions of items on the secured stack; and
- securing the secure stack upon receipt of a stack restaple operation.

Wang teaches:

- opening a secured stack upon receipt of a stack open instruction; presenting the contents of the secured stack for perusal by the user (a review of the document relation object 48 of FIG. 2 indicates that the document to be deleted forms a portion of a relationship with another document; col.5, lines 57-66);

- accepting additions and deletions of items on the secured stack (reverse search index object 58...support the removal of search index entries...the addition or deletion of data objects; col. 5, lines 19-34); and

- securing the secure stack upon receipt of a stack restaple operation (access control model object 44... contains access control information... identify those users or groups of users to whom some form of access authority to the document has been granted; col.4, lines 37-44).

### ***Response to Arguments***

4. Applicant's arguments filed 07/16/2003 have been fully considered but they are not persuasive.

Applicant argues that *Khan does not disclose or suggest "cryptographically securing the staple data object in response to receipt of the staple instruction, thereby indicating the existence of the association of selected pages and selected documents together at one time."* (Remarks, page 5, lines 24-26)

In response, the Examiner disagrees. Khan teaches cryptographically securing the staple data object in response to receipt of the staple instruction (the concatenation is then presented to the conventional cryptographic; col.11, lines 23-34). Wang teaches the existence of the association of selected pages and selected documents together at one time (*if the present document ... object 48; col.4, lines 52-68 & determination of whether or not a relationship exists between the document; col.5, lines 44-51*).



Applicant argues that *Khan does not disclose creating any type of association between documents*. (Remarks, page 6, lines 19-20).

In response, the Examiner contends that the teaching of Wang “it is now possible to electronically group multiple documents together in a manner which is analogous with paper office techniques; col.1, line 55 – col.2, line 12” and “a temporary electronically designated folder; Abstract /associated pages of a single document can be visually identified and electronically “stapled” or assembled together with appropriate software ...a cover page which contains both machine and human-readable information col.1, line 45 – col.2, line 44” do read-on the limitation as claimed by Applicant.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Anderson et al.	U.S Patent No. 6,609,200	issue dated: Aug.19, 2003
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Haber et al.	U.S Patent No. 5,781,629	issue dated: Jul. 14, 1998
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6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2176

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Field can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

**Contact Information:**

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.  
OFFICIAL faxes must be signed and sent to (703) 872-9306.  
NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Art Unit: 2176

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen  
September 27, 2003

A handwritten signature in black ink, appearing to read "Sanjiv Shah", with a stylized flourish at the end.

SANJIV SHAH  
PRIMARY EXAMINER